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EXAMINER

DAO, THUY CHAN

ART UNIT

PAPER NUMBER

2192

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/047,769	<b>Applicant(s)</b> KLAVE ET AL.	
	<b>Examiner</b> Thuy Dao	<b>Art Unit</b> 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 47-53,55-63,65-72,74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-53,55-63,65-72,74 and 75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the amendment filed on July 8, 2008.
2. Claims 47-53, 55-63, 65-72, and 74-75 have been examined.

### **Response to Amendments**

3. In the instant amendment, claims 47, 57, and 67 have been amended.
4. The objection to the specification is withdrawn in view of Applicant's amendments.

### **Response to Arguments**

5. Applicants' arguments have been considered but are not persuasive.
  - a) Rejection of Claims 47-53, 55-63, 65-72, and 74-75 Under 35 U.S.C. § 103(a):  
Claims 47-53, 55-63, 65-72 and 74-75 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 7,212,306 to Chrisop et al. ("Chrisop") in view of U.S. Patent No. 7,148,980 to Tominaga ("Tominaga").

The Applicants asserted,

“Applicants are attaching in Appendix B a redacted agreement between Sharp Laboratories of America, Inc. and Sharp Corporation (a.k.a. Sharp Kabushiki Kaisha). The date of the agreement is July 1, 1995. (See page 1 of the agreement.) The present application was filed on January 15, 2002. Thus, at the time the present invention was made, both the Chrisop reference and the present application were subject to an obligation of assignment to Sharp Corporation (a.k.a. Sharp Kabushiki Kaisha)” (Remarks, page 11, first paragraph).

The examiner respectfully disagrees. As set forth in previous Office actions (mailed June 21, 2007 and April 8, 2008),

“...The reference Chrisop (US Patent No. 7,212,306, only 2 inventors Chrisop and Klave) was filed on August 31, 2001, assigned to Sharp Laboratories of America, Inc. on September 29,

2005, and subsequently assigned to Sharp Kabushiki Kaisha on June 12, 2007.

The instant application was filed on January 15, 2002 (3 inventors Chrisop, Klave, and Sojian) and assigned to Sharp Laboratories of America, Inc. on January 15, 2002.

The instant application and the Chrisop reference, at the time the invention was made, were not owned by the same person or subject to an obligation of assignment to the same person or organization ...) (emphasis added).

As examiner pointed out in previous Office actions (mailed June 21, 2007 and April 8, 2008), MPEP 706.02(I)(2)(II) clearly sets forth:

“It is important to recognize just what constitutes sufficient evidence to establish common ownership at the time the invention was made. The common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. In re Onda, 229 USPQ 235 (Comm'r Pat. 1985)” (emphasis added).

reference	instant app.	ref. assigned to Sharp
2001 Chrisop Klave	2002 assigned to Sharp Chrisop Klave Sojina	2005

That is to say, at the time the invention was made (January 15, 2002), the reference Chrisop was owned by 2 inventors Chrisop and Klave, wherein the instant application (3 inventors Chrisop, Klave, and Sojian) was assigned to Sharp Laboratories of America, Inc.

Accordingly, the reference Chrisop cannot be disqualified as prior art for purposes of 35 USC 103(c) and the examiner respectfully maintains ground of the 35 U.S.C. § 103(a) rejection over claims 47-53, 55-63, 65-72, and 74-75.

b) Admitted Prior Art (APA):

As Applicants pointed out, "...As can clearly be seen, the cited portion of Applicants' specification does not say anything about a 'loading table' ..." (Remarks, page 13, last paragraph).

In view of Applicants' persuasive arguments, in this Office action, the examiner withdraws the 35 U.S.C. § 103(a) rejection over claims 47, 57, and 67 in view of APA and Tominaga.

c) The reference Tominaga US Patent No. 7,148,980 (Remarks, pp. 14-15):

First, the "output device administration table" in Tominaga is not stored on a multi-functional peripheral (Remarks, page 14, fourth paragraph).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case:

Chrisop (main reference) explicitly teaches "a memory configuration table" (col.4: 25-32; FIG. 3 and related text), i.e., "a loading table", stored on a multi-functional peripheral (e.g., col.4: 46 – col.5: 8);

Tominaga (secondary reference) further teaches another loading table, which include license information for Multi-Function Peripherals MFPs (e.g., FIG. 26, col.16: 59 – col.17: 18, Administration Table with column "License", which indicates individual software components of multi-function peripheral MFP104 are not loaded).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One

would have been motivated to do so to substantiate the validity of use of certain print/fax/san software as suggested by Tominaga (e.g., col.11: 37-64).

Second, the newly added limitations "a plurality of individual software components, wherein the software components comprise software libraries" (claim 1, lines 7-8 and Remarks, page 14, fifth paragraph).

The examiner respectfully disagrees with Applicants' arguments. As explicitly defined in the originally filed disclosure, page 6, lines 13-15, "...Typically, the software components 204 are software libraries that include the functionality necessary for operation of one or more features or components" (emphasis added).

In light of the originally filed disclosure, Chrisop explicitly teaches *a plurality of individual software components, wherein the software components comprise software libraries* (e.g., FIG. 1, multi-functional peripheral 100 includes Fax 110, Scanner 112, Printer 114, Copier 116; FIG. 3, software components provide functionality necessary for operation of Copier with max memory allocation 40MB, of Printer with max memory allocation 50MB, ...; FIG. 4, block 409a "Prioritizing MFP functions" → block 409b "Allocating additional RAM to contending MFP functions").

Third, other limitations (Remarks. pp. 14-15):

The examiner respectfully disagrees with Applicants' arguments. As explicitly defined in dependent claims 52, 62, and 71, "...wherein the loading table is a license table comprising a list of licenses relating to the individual software components".

In light of the claimed language, Tominaga explicitly teaches:

*a loading table that indicates which of the plurality of individual software components are loaded into the volatile memory and which of the plurality of individual software components are not loaded into the volatile memory* (e.g., FIG. 26, col.16: 59 – col.17: 18, Administration Table with column "License", which indicates individual software components of multi-function peripheral MFP104 are not loaded),

*wherein the individual software components that are loaded into the volatile memory correspond to a configuration of the multi-function peripheral* (e.g., FIG.

26, Printer Type, Printer Name, IP Address, Finishing Option; FIG. 28B, step S2830 “Does Printer Need License? YES/NO”, col.18: 50 – col.19: 32), and

*wherein the individual software components that are not loaded into the volatile memory do not correspond to the configuration of the multi-functional peripheral (e.g., FIG. 30, B/W MFP 105 – Printer 7 Offline, License Violation, col.18: 25-42; FIG. 27, the individual software components require license, which do not correspond to MFP105 “No Available License”);*

*instructions stored in the non-volatile memory that are executable to: examine the loading table to determine which of the plurality of individual software components are to be loaded into the volatile memory (e.g., FIG. 29 and 26, loading table, col.16: 59 – col.17: 18; FIG. 28B, examining loading table); and*

*load each of the plurality of individual software components that are to be loaded, as indicated in the loading table, into the volatile memory so that these software components are all loaded into the volatile memory at the same time (e.g., FIG. 26, FIG. 28B, col.18: 50 – col.19: 32); and*

*not load any of the plurality of individual software components that are not to be loaded into the volatile memory as indicated in the loading table (e.g., col.18: 25-42; FIG. 30, License Violation at B/W MFP 105).*

In conclusion, Applicants’ arguments are not persuasive. The examiner respectfully maintains the 35 USC §103(a) rejection over claims 47-53, 55-63, 65-72, and 74-75 in view of Chrisop and Tominaga.

### **Claim Rejections – 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 47-53, 55-63, 65-72, and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrisop (art of record, US 7,212,306) in view of Tominaga (art of record, US Patent No. 7,148,980).

**Claim 47:**

Chrisop discloses *a multi-functional peripheral comprising a printer configured to reduce volatile memory usage by selectively loading some individual software components and not loading other individual software components, the multi-functional peripheral comprising:*

*a processor (e.g., col.1: 12-17);*

*volatile memory in electronic communication with the processor (e.g., col.1: 17-25);*

*non-volatile memory in electronic communication with the processor (e.g., col.1: 26-37) comprising:*

*a plurality of individual software components (e.g., col.1: 12-25),*

*wherein the software components comprise software libraries (e.g., FIG. 1, multi-functional peripheral 100 includes Fax 110, Scanner 112, Printer 114, Copier 116; FIG. 3, software components provide functionality necessary for operation of Copier with max memory allocation 40MB, of Printer with max memory allocation 50MB, ...; FIG. 4, block 409a "Prioritizing MFP functions" → block 409b "Allocating additional RAM to contending MFP functions"); and*

*load each of the plurality of individual software components that are to be loaded, into the volatile memory so that these software components are all loaded into the volatile memory at the same time (e.g., col.1: 26-47; col.4: 25-32; FIG. 3 and related text, a memory configuration table stored on a multi-functional peripheral, col.4: 46 – col.5: 8).*

In an analogous art, Tominaga further discloses:



*a loading table that indicates which of the plurality of individual software components are loaded into the volatile memory and which of the plurality of individual software components are not loaded into the volatile memory (e.g., FIG. 26, Administration Table with column “License”, col.16: 59 – col.17: 18),*

*wherein the individual software components that are loaded into the volatile memory correspond to a configuration of the multi-function peripheral (e.g., FIG. 26, Printer Type, Printer Name, IP Address, Finishing Option; FIG. 28B, step S2830 “Does Printer Need License? YES/NO”, col.18: 50 – col.19: 32), and*

*wherein the individual software components that are not loaded into the volatile memory do not correspond to the configuration of the multi-functional peripheral (e.g., FIG. 30, B/W MFP 105 – Printer 7 Offline, License Violation, col.18: 25-42);*

*instructions stored in the non-volatile memory that are executable to: examine the loading table to determine which of the plurality of individual software components are to be loaded into the volatile memory (e.g., FIG. 29 and 26, col.16: 59 – col.17: 18); and*

*load each of the plurality of individual software components that are to be loaded, as indicated in the loading table, into the volatile memory so that these software components are all loaded into the volatile memory at the same time (e.g., FIG. 26, FIG. 28B, col.18: 50 – col.19: 32); and*

*not load any of the plurality of individual software components that are not to be loaded into the volatile memory as indicated in the loading table (e.g., col.18: 25-42).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga’s teaching into Chrisop’s teaching. One would have been motivated to do so to substantiate the validity of use of certain software as suggested by Tominaga (e.g., col.11: 37-64).

**Claim 48:**

The rejection of claim 47 is incorporated. Chrisop also discloses *the multi-functional peripheral is a printer/fax/copier* (e.g., col.1: 12-25).

**Claim 49:**

The rejection of claim 47 is incorporated. Tominaga further discloses *an input component in electronic communication with the processor for a user to enter user input and thereby configure the loading table* (e.g., col.16: 59 – col.17: 18).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claim 50:**

The rejection of claim 49 is incorporated. Tominaga further discloses *a display in electronic communication with the processor that displays information to the user relating to the loading table* (e.g., col.18: 25-42).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claim 51:**

The rejection of claim 50 is incorporated. Tominaga further discloses *a menu structure that may be navigated by a user using the input component and the display to configure the loading table* (e.g., col.18: 50 – col.19: 32).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claim 52:**

The rejection of claim 47 is incorporated. Tominaga further discloses *the loading table is a license table comprising a list of licenses relating to the individual software components* (e.g., col.16: 59 – col.17: 18).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claim 53:**

The rejection of claim 52 is incorporated. Chrisop also discloses *the individual software components with licenses, as indicated by the license table, are loaded into the volatile memory* (e.g., col.18: 25-42).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claim 55:**

The rejection of claim 47 is incorporated. Chrisop also discloses *a communications module in electronic communication with the processor for communications with a computer; and a web interface accessible by a user through use of a web browser to configure the loading table* (e.g., col.3: 26 – col.4: 55).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claim 56:**

The rejection of claim 47 is incorporated. Tominaga further discloses *examine a hardware configuration by a loader application; and modify the loading table based on the hardware configuration* (e.g., col.4: 31 – col.5: 59).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Tominaga's teaching into Chrisop's teaching. One would have been motivated to do so as set forth in claim 47 above.

**Claims 57-63 and 65-66:**

Claims 57-63 and 65-66 recite the same limitations as those of claims 47-53 and 55-56, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claims, they also teach all of the limitations of claims 57-63 and 65-66.

**Claims 67-72 and 74-75:**

Claims 67-72 and 74-75 recite the same limitations as those of claims 47-53 and 55-56, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claims, they also teach all of the limitations of claims 67-72 and 74-75.

**Conclusion**

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/  
Examiner, Art Unit 2192

/Tuan Q. Dam/  
Supervisory Patent Examiner, Art Unit 2192